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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: KESTON, R.J. ET AL.
Serial No.: 09/724,691
Filed: NOVEMBER 28, 2000
For: INTRA-AORTIC RENAL DRUG DELIVERY CATHETER
Group No.: 3763
Examiner: GHAFOORIAN, ROZ
Docket No.: 26842-1060 (FLO5360.03A)

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESPONSE

Dear Sir:

This communication is responsive to the Office Action mailed April 08, 2002.

1. Election of Species Requirement.

The Office Action required election of a single disclosed species in the Application as follows:

"...figures 1-7, figures 8a-8b, figures 0a-9b, figures 10-12, figure 13, figure 16 and figure 17."

Applicants respond to the required election of species by electing the alleged species corresponding with Figures 1-7. Applicants further identify Claims 1-5, 8-11, and 16-22 as covering the elected Species. Because the various features described in Claims 6-7 and 12-15 are not specifically shown in Figures 1-7, these claims are therefore withdrawn, and are intended to be re-instated upon allowance of a generic claim, of which there are several believed to be generic in the application as follows.

Notwithstanding the election made, Applicants traverse the election requirement because several of the claims in the Application are believed to be generic to all the

identified alleged species in the Office Action, including the elected species, as follows.

Claim 1 is generic to all of the species identified in the Office Action and recites the following:

1. A catheter for controlling blood flow to a branch vessel of a blood vessel, comprising:
 - a) an elongated shaft;
 - b) a tubular member on a distal section of the shaft having an interior passageway which is radially expandable within a blood vessel to separate blood flow through the blood vessel into an outer blood flow stream exterior to the tubular member and an inner blood flow stream within the interior passageway of the tubular member, and which is configured to extend within the blood vessel upstream and downstream of a branch vessel; and
 - c) a radially expandable member on the tubular member, having an expanded configuration with an outer diameter larger than an outer diameter of the tubular member and which is configured to direct at least part of the blood flow in the outer blood flow stream into the branch vessel.

The elected species corresponding to Figures 1 to 7 is clearly covered by this claim, including examples of the elongated shaft at 11, tubular member at 13, and expandable member at balloon 14 (or designated at 42 in Figure 7).

As for the alleged species related to Figures 8a-b, and also alleged species related to Figures 9a-b, these are merely alternative embodiments providing specific collapsing/expansion characteristics for tubular member 13. These Figs. 8a-9b are further described together in the Application at page 20 line 16 to page 21 line 8.

As for the alleged species related to Figures 10-12, these figures merely illustrate an alternative embodiment for providing the collapsible/expandable structure for tubular member 13. Though highly a beneficial particular embodiment, it nevertheless still meets the limitations of, e.g. falls within the scope of, claim 1. A further understanding of these Figures 10-12 and their relation to the invention

embodied in claim 1 may be found by reference to the Application at page 22, line 1 to page 23, line 2.

As for Figures 13, 16, and 17, these were each identified in the Office Action as their own distinct species, but merely provide further particular embodiments for the tubular and expandable members of claim 1. For example, Figures 13 and 17 each show a frusto-conical shaped tubular member having a tapered diameter from smaller diameter upstream end to a larger diameter downstream end that "forms the radially expandable member 14." (page 23, line 21 to page 24, line 2). These embodiments are shown and described in a manner that clearly is contemplated under the meaning of claim 1, and in fact this aspect of them are further defined as subordinate to claim 1 by further reference to claim 7, which depends from claim 1 and requires that "the radially expandable member comprises a radially enlarged section of the tubular member." While Figure 16 does not explicitly show all the elements of claim 1, it is described as an alternative embodiment for the tubular member 13 of the claim by incorporating a plurality of inflatable balloons 54 to provide the expansion capability for that element. Such embodiment may not require combination with all other features of the other embodiments, or with respect to claim 1, but may nevertheless be so combined as described in the Application at page 26, line 22 to page 27, line 2 as follows: "...while certain features may be shown or discussed in relation to a particular embodiment, such individual features may be used on the various other embodiments of the invention."

Applicants further believe that this language in the Application recited immediately above further allow one of ordinary skill in the art to combine the features

of claims 6-7 and 12-15 with the features shown in Figures 1 to 7, in particular upon review of the entirety of the Application. Nevertheless, Applicants concede to withdraw these from consideration as non-elected in order to expedite examination.

Independent Claim 18 is a method claim related to a certain mode of using a device similar to that provided in Claim 1, as further understood by comparing the sub-paragraph "a)" of Claim 18 with Claim 1. Claim 21 is another apparatus claim similar to that of Claim 1 to the extent that both claims generally require: (a) an elongated shaft; (b) a tubular member; and (c) a radially expandable member. Claim 22 is a method claim related to a certain mode of using a catheter similar to that provided in Claim 21, as further understood by comparing the sub-paragraph "a)" of Claim 22 with Claim 21. All these other independent Claims are also generic to all of the alleged species for the same reasons noted above with respect to Claim 1.

According to the remarks above, each independent Claim ~~1, 18, 21, and 22~~ is generic to all of the disclosed species, and hence Applicants traverse the species election requirement, despite having elected the species corresponding to figures 1-7 in the Office Action.

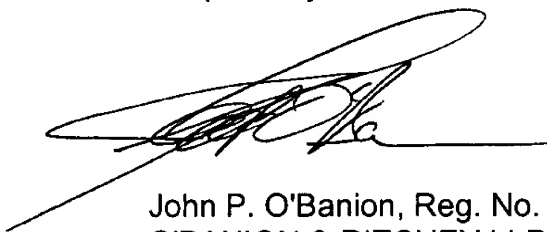
2. Conclusion.

In view of the above, Applicants have responded sufficiently to the requirements to elect one species alleged in the Office Action. Applicants have further identified that all of the independent claims in the Office Action are generic to the elected species, in addition to the other non-elected species. Each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to allow this application to issue.

The Applicants also respectfully request a telephone interview with the Examiner in the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims.

Date: 3/13/2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John P. O'Banion', written over a horizontal line.

John P. O'Banion, Reg. No. 33,201
O'BANION & RITCHEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010

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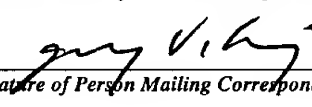
Group Art Unit

3763Invention: **INTRAVASCULAR RENAL DRUG DELIVERY CATHETER**

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Response (Page 1 thru 5)*(Identify type of correspondence)*

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